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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,227	04/04/2001	Jeremy Klug	P-1030	2460

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EXAMINER

BOSS, WENDY L

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 02/07/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-7

**Office Action Summary**

Application No.

09/826,227

Applicant(s)

KLUG, JEREMY

Examiner

Wendy Boss

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102/103*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 4,961,991 (Howard) in view of U.S. Patent No. 4,591,166 (Atkinson et al.) and “Typical Grafoil® sheet properties”.

Howard discloses a material comprising a flexible graphite sheet that is relatively void-free (see column 2, lines 16-61). Howard further discloses that the flexible graphite sheet is impregnated with a phenolic-based resin (see column 2, lines 25-61). Howard also discloses a process for producing a material comprising forming a flexible graphite sheet and manipulating the void condition to produce a relatively void-free material. It is also disclosed by Howard that the flexible graphite sheet is subjected to pressure (see column 2, lines 25-61). Howard does not specifically recite the density of the flexible graphite sheet; however, it is disclosed that the

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flexible graphite sheet is preferably Grafoil®. Attention is directed to "Typical Grafoil® sheet properties", which teaches that the density of Grafoil® 1.1 g/cc.

Howard further discloses a process for producing a material useful as a substrate comprising forming a flexible graphite sheet and manipulating the void condition to the flexible graphite sheet to produce a selected void condition (see column 2, lines 58-65).

Howard also does not specifically disclose that the material is used as a substrate for an embossed flexible graphite sheet or that the graphite sheet is to be embossed; however, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the alternative, Howard does not specifically disclose that the material is used as a substrate for an embossed flexible graphite sheet; however, it is disclosed that the graphite sheet may be used as a gasket. Attention is directed to column 1, lines 41-65 of Atkinson, which teaches that gaskets can be more readily removed if they are subjected to embossing treatment. Such a teaching would have motivated on having ordinary skill in the art to emboss the Howard gasket.

4. Claims 1-3 and 10-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,017,633 (Mercuri) in view of U.S. Patent No. 4,591,166 (Atkinson et al.).

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Mercuri discloses a material comprising a flexible graphite sheet that is relatively void-free (see column 5, lines 20-29). Mercuri also discloses a process for producing a material comprising forming a flexible graphite sheet and manipulating the void condition to produce a relatively void-free material.

Mercuri further discloses a process for producing a material useful as a substrate comprising forming a flexible graphite sheet and manipulating the void condition to the flexible graphite sheet to produce a selected void condition (see column 5, lines 20-29). The flexible graphite sheet in the reference is also subjected to the application of pressure to provide the selected void condition (see column 5, lines 20-21).

Mercuri does not specifically disclose that the material is used as a substrate for an embossed flexible graphite sheet; however, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the alternative, Mercuri does not specifically disclose that the material is used as a substrate for an embossed flexible graphite sheet; however, it is disclosed that the graphite sheet may be used as a gasket. Attention is directed to column 1, lines 41-65 of Atkinson, which teaches that gaskets can be more readily removed if they are subjected to embossing treatment. Such a teaching would have motivated on having ordinary skill in the art to emboss the Mercuri gasket.

***Response to Arguments***

5. Applicant's arguments filed November 18, 2002 have been fully considered but they are not persuasive. The applicant argues that the rejections under 35 U.S.C. 102(b) by U.S. Patent No. 4,961,991 (Howard) in view of additional references or U.S. Patent No. 6,017,633 (Mercuri) in view of U.S. Patent No. 4,591,166 (Atkinson et al.) is improper since the subject matter cannot be anticipated if a combination of references is required. Attention is directed to MPEP 2131.01, which shows circumstances where an anticipation rejection using multiple references is proper. Regarding the rejection under 35 U.S.C. 102(b) by Howard in view of "Typical Grafoil® sheet properties", the secondary reference is relied upon solely to establish the density of Grafoil. The Atkinson reference is only applied for an alternative rejection under 35 U.S.C. 103(a). Regarding the rejection under the Mercuri reference, it is the examiner's position that the reference is a proper reference alone under 35 U.S.C. 102(b), or alternatively under 35 U.S.C. 103(a) when combined with the Atkinson reference.

The applicant also argues that the claimed invention relates to a material and process specially design/prepared so that the internal structure can be manipulated to provide different end-use morphologies/properties; however, the examiner could not find such limitations in the pending claims.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy Boss whose telephone number is 703-306-5922. The examiner can normally be reached on M-Th 8:30a-6:00p; 2nd F 8:30a-5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 703-308-3822.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Wendy Boss  
February 5, 2003

  
**DEBORAH JONES**  
**SUPERVISORY PATENT EXAMINER**